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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,455	02/26/2004	Kevin Morrison	020375-043010	5172
20350	7590	04/21/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/789,455

Applicant(s)

MORRISON ET AL.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt is acknowledged of amendments filed on 1/26/2005.
2. Claims 1-27 are presented for examination.
3. This application claims the benefits of provisional application No. 60/520,432 filed on 11/14/2003.

### ***Claim Objections***

4. Claims 1, 10, 13, and 21 are objected to because of the following informalities:

The applicant recites the limitations “that may be used”, wherein such language is regarded and broadly interpreted as an optional limitation (i.e. may be or may be not). The applicant is respectfully requested to correct the limitations by substituting “that may be used” with “used” so as to clearly identify the intends/purposes of the presentation instruments.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaros et al. (U.S. 6,877,656) in view of Audren (U.S. 5,799,316).

Re claims 1, 10, 13, and 21: Jaros et al. discloses systems, methods and apparatus for instant issuance of a credit card, which includes receiving at a host computer system a request

Art Unit: 2876

from a purchaser to order a presentation instruments, wherein a presentation instrument comprises a physical device [herein a credit card] used to settle a financial transaction (col.5, lines 30+); sending one or more files [i.e. application forms to redeem personal information from the requestor/purchaser] that are executable by a computer of the purchaser to produce one or more corresponding display screens programmed to collect purchase information relating to the plurality of presentation instruments (col.5, lines 45+); receiving at the host computer system the purchase information from the purchaser, wherein the purchase information comprises a recipient information [herein name of the customer to be printed on the card] file (col.7, lines 35+); and delivering [herein Jaros et al. discloses instant issuing credit card from a card dispenser or mail delivering system] the presentation instruments in accordance with the purchase information (col.5, lines 60+).

Jaros et al. suggests an apparatus and method that are provided for instantly issuing credit cards using a remote dispenser (col.3, lines 30+), but fails to teach a request from a purchaser to order a plurality [such a batch/bulk of cards] of presentation instruments from a host computer.

Audren teaches method for the batch customization of cards, which includes a purchaser to order a plurality [such a batch/bulk of cards] of presentation instruments from a host computer (col.1, lines 55+; col.3, lines 35+).

In view of Audren's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Jaros et al. means of receiving from a host computer request from a purchaser to order a plurality of presentation instruments from a host computer so as to permit the purchaser an opportunity to apply for a plurality of presentation instruments [herein referred as a credit, prepaid, gift card or the like]

Art Unit: 2876

used to settle financial transactions. Furthermore, such modification would enable the purchaser [such a retailer] to order a bulk of cards for business use, or a few customized [credit or gift] cards for personal use wherein embossed information to be printed on each/group card as per the purchaser's request. Moreover, such modification would have been an obvious extension as taught by Jaros et al., therefore an obvious expedient.

Re claims 2, 11, 19, and 23: Jaros et al. teaches an apparatus and method, wherein the presentation instruments comprise a selection from the group of consisting of credit cards, gift cards, smart cards, stored valued cards and debit cards (col.3, lines 47+).

Re claims 3-5, 8-9, 15-17, 22, and 26-27: Jaros et al. discloses an apparatus and method, wherein delivering the presentation instruments in accordance with the purchase information comprises delivering [herein described as instant issuing or mailing system] the presentation instruments to the customer (col.5, lines 62+), embossed information to be encoded on the card (col.7, lines 35+; col.9, lines 45+). Jaros et al. does not specifically disclose means of delivering the presentation instruments to each of a plurality of recipients, or a designee, a message or a recipient name to be embossed on each card.

However, since the system is designed to mail the card to the requestor after the application is completed and approved, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to implement into the operating software of Jaros et al. a subroutine prompting the requestor as to whether the card should be mailed/delivered the presentation instruments to each of a plurality of recipients, or a designee. Furthermore, such modification would enable the requestor the option of customize a plurality of [gift] cards with the designee/recipient(s) information embossed on the card and to have the card(s) to be mailed

Art Unit: 2876

to each recipient. Moreover, such modification would have been an obvious extension as taught by Jaros et al.

Re claims 6, 12, 14, and 24: Jaros et al. teaches an apparatus and method, further comprising receiving at the host computer system a request from a user to view usage information relating to a presentation instrument and sending a file to a computer of the user, wherein the file comprises the usage information (col.7, lines 8+).

Re claims 7, 18, and 25: Jaros et al. discloses an apparatus and method, wherein the recipient information file comprises a selection from the group consisting of a spread sheet, text file and a data file (col.6, lines 5-67).

Re claim 20: Jaros et al. teaches an apparatus and method, wherein the presentation instruments comprise non-personalized [herein broadly interpreted as a conventional credit card with the embossing standards, i.e. the card issuer logo {MasterCard, Visa, and the like}, name of the cardholder, expiration date, and the like] cards (col.5, lines 60+; col.7, lines 32+).

### *Response to Arguments*

7. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Masuda (U.S. 5,883,452) teaches credit card system and method of issuing credit card issuing such a system.

Cunningham (U.S. 6,014,645) discloses real-time financial card application system.

Lent et al. (U.S. 6,405,181) teaches method and apparatus for real time on line credit approval.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
April 13, 2005



**THIEN M. LE**  
**PRIMARY EXAMINER**